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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,140	02/11/2004	Graham Cristopher Young	003-113	2435
36844	7590	10/18/2005		
CERMAK & KENEALY LLP 515 E. BRADDOCK RD ALEXANDRIA, VA 22314			EXAMINER OMGBA, ESSAMA	
			ART UNIT 3726	PAPER NUMBER

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,140

Applicant(s)

YOUNG, GRAHAM CRISTOPHER

Examiner

Essama Omgba

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8, 10, 12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Caminez (US Patent 2,244,824).

With regards to claims 1-3, 8 and 12, Caminez discloses an extraction tool for extracting spiral threaded inserts, the tool comprising an elongated basic body 2 with an extracting tip 3 at one end, the extracting tip narrowing toward the front and adapted to be inserted into a threaded insert and cut into the insert, means 4 provided at another end for turning the extraction tool, wherein a section of the tip has the shape of a steep-angle truncated pyramid with a square cross section with the angle of inclination of the faces of the truncated pyramid relative to a central axis thereof being only a few degrees, see the first page and the drawings. Applicant should note that the tool of Caminez could be inserted by means of blows on its rear end and that it is inherent that the tool of Caminez is made of hardened steel.

For claim 10, head 1 of the tool of Caminez could be considered an impact adapter.

For claim 17, Applicant should note that the structure the inspection port lend no patentable weight to the method being claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-7, 9, 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caminez.

With regards to claims 4-7, Caminez discloses an extraction tool as shown above except for the extraction tip being screwed to the basic body using a fastening screw. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the extracting tip and the basic body of the tool of Caminez in various elements since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Applicant should note that having the adjoining section of the extracting tip be in the shape of a square section is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in having the adjoining section be in the shape of a square section versus the shape taught by Caminez as long as the tool is adapted to apply torque to the threaded insert. Also it is well within the general knowledge of one of ordinary skill in the art to appropriately connect the various elements together.

With regards to claim 9, Caminez discloses an extraction tool as shown above including means for turning the extraction tool. Although Caminez does not disclose a hexagonal tubular piece as the means for turning the tool, however it is within the general knowledge of one of ordinary skill in the art to provide appropriate means for turning the tool. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided the tool of Caminez with a hexagonal tubular piece for turning the tool, as is within the general knowledge of one of ordinary skill in the art.

For claims 11 and 16, Applicant should note that providing the basic body as a plurality of parts connected to each other by welding is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in providing the tool body as a plurality of parts welded together versus an integral one piece as taught by Caminez.

For claim 14, Applicant should note that the structures of the insert and of the inspection port lend no patentable weight to the method being claimed.

Allowable Subject Matter

5. Claims 13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Essama Omgba
Primary Examiner
Art Unit 3726

eo
October 15, 2005